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(General - Patent Pending)**

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LIPM-3298

Re Application Of: **Ruth Lipman**

Serial No.
10/035,305

Filing Date
11/09/01

Examiner
Coe, Susan D.

Group Art Unit
1654

Title: **METHOD, APPARATUS AND COMPOSITION FOR REPELLING ANIMALS**

TO THE COMMISSIONER FOR PATENTS:

Transmitted herewith is:

Reply Brief (15 pages)

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Dated: **05/17/2004**

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AF/1654 IFW

DOCKET NO. LIPM-3298

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ruth Lipman

Examiner: Coe, Susan D.

Serial No.:10/035,305

Art Unit:1654

Filed: 11/09/01

For: **METHOD, APPARATUS AND COMPOSITION FOR REPELLING ANIMALS**

Honorable Commissioner for Patents
P.O. Box 1450
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REPLY BRIEF OF APPELLANTS

This Reply Brief, which addresses issues raised in Examiner's Answer mailed March 15, 2004, discusses the Examiner's Grounds of Rejection and the Examiner's Response to Appellants' Arguments with respect to the two issues under appeal:

1. Whether Claims 1-4 and 6-12 are unpatentable under 35 U.S.C. 103(a) over US Patent No. 5,417,973 ("U.S. '973") in view of U.S. Patent No. 4,965,070 ("U.S. '070").
2. Whether Claims 1-3, 7, 11 and 12 under 35 U.S.C. 103(a) are unpatentable over Japanese Patent Application No. 1-139515 A ("U.S. '515 A") in view of U.S. Patent No. 4,965,070 ("U.S. '070").

Issue 1

Claims 1-4, and 6-12 Are Not Unpatentable Under 35 U.S.C. 103(a) Over US Patent

No. 5,417,973 ("U.S. '973") in view of US Patent No. 4,965,070 ("U.S. '070") Because There

Is No Motivation to Combine U.S. '973 in View of U.S. '070 and Therefore the

Combination Is Improper.

Claims 1-4 and 6-12

As to whether there is no motivation to combine U.S. '973 in view of U.S. '070 and therefore the combination is improper, the Examiner's Answer states:

"a person of ordinary skill in the art would recognize that the repellant composition taught by US '973 could be used to repel animals **from any surface that is known to be at risk for animal damage**. Therefore, an artisan of ordinary skill in the art would be motivated to use the repellant of US '973 on the surfaces claimed by applicant" (emphasis added). The Examiner's Answer, page 3, paragraph 10.

Appellant respectfully submits that the preceding argument by the Examiner is vague and indefinite because the Examiner has not explained how the Examiner's statement, *supra*, supports the Examiner's rejection of Claims 1-4, and 6-12, as allegedly unpatentable under 35 U.S.C. 103(a) over U.S. '973 in view of U.S. '070. To establish a *prima facie* case of obviousness, three basic criteria must be met.

"First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP, §2143.

The Examiner states that it would be recognizable to a person of ordinary skill in the art that the repellant composition taught by US '973 could be used to repel animals **from any surface that is known to be at risk for animal damage**. However, the Examiner does not reference any supporting passages or other evidence in the cited prior art for the conclusion that “the repellant composition taught by US '973 could be used to repel animals **from any surface that is known to be at risk for animal damage**.” Id. In fact, the Examiner acknowledges that the primary reference US '973 does not specifically teach applying the repellant to the same substrates, **namely to plants**, as in Claims 1-4 and 6-12. See Id.

Appellant respectfully submits that the Examiner has created a reason for the combination, i.e., the statement, *supra*, that “a person of ordinary skill in the art would recognize that the repellant composition taught by US '973 could be used to repel animals **from any surface that is known to be at risk for animal damage**. . .,” (emphasis added) that the Examiner has not supported by the cited prior art.

The Examiner acknowledges that the primary reference US '973 does not specifically teach applying the repellant to the same substrates, **namely to plants**, as in Claims 1-4 and 6-12. See Id. The only possibilities for modifying the primary reference of U.S. '973 with the

secondary reference of U.S. '070 is to either: replace the animal of U.S. '973 with the **plant** of U.S. '070 or add the **plant** of U.S. '070 to the animal of U.S. '973. The combination of U.S. '973 and U.S. '070 is improper because modifying U.S. '973 to replace the animal **carcass** of U.S. '973 with the **plant** of U.S. '070 would destroy the teaching of '973, i.e., to repel pests from an animal **carcass**. U.S. '973 requires "preserving and preventing pest damage to an animal **carcass** or skin" (emphasis added). U.S. '973, column 2, lines 14-16. Additionally, nowhere does U.S. '973 teach or suggest placing a **plant** on the animal **carcass** for any purpose. Additionally, U.S. '973 doesn't need the addition of a **plant** to protect the **carcass**. Since protecting a **plant** is outside the scope of U.S. '973, Appellant respectfully contends that "a person of ordinary skill in the art would **not** recognize that the repellent composition taught by US '973 could be used to repel animals **from any surface that is known to be at risk for animal damage. . .**" (emphasis added). See U.S. '973 generally, columns 1-2 and Examples. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention.")). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification.")). Appellant maintains that the Examiner has not made any showing of where the

prior art suggests that the repellent composition taught by US '973 could be used to repel animals **from any surface that is known to be at risk for animal damage. . .**" (emphasis added). Thus, the Examiner has created a reason for the combination that the Examiner has not supported by the cited prior art. By not citing any suggestion or incentive in the prior art that the repellent composition taught by US '973 could be used to repel animals **from any surface that is known to be at risk for animal damage. . .**" (emphasis added), the Examiner has failed to establish a *prima facie* case of obviousness in relation to Claims 1-4 and 6-12.

Regarding the 103(a) rejection based on the combination of US Pat. No. 5,417,973 and US Pat. No., 4,965,070, the Examiner's Answer recites appellant's arguments that there is no motivation to combine the teachings of these two references together. Firstly, the Examiner recites appellant's argument that the combination is improper because U.S. '973 teaches repelling pests such as insects and birds from animal carcasses while U.S. '070 teaches repelling pests such as deer from plants. Secondly, the Examiner recites appellant's argument that the only means for modifying the teachings of the reference would be to either replace the carcass of U.S. '973 with the plant of U.S. '070 or add the plant of U.S. '070 to the carcass of U.S. '973. Thirdly, the Examiner recites that appellant contends that such a replacement would destroy the teaching of U.S. '973, the primary reference, because the substrate that is taught as needing protection, i.e., **the animal carcass**, is not present in U.S. '070. Fourthly, the Examiner recites appellant's argument that repelling an animal from carcasses and plants are not analogous problems and that an animal that could potentially approach a plant would not necessarily approach an animal carcass.

Appellant respectfully submits that the Examiner's argument for combining U.S. '973 in

view of U.S. '070 is vague and indefinite because the Examiner's Answer is silent with respect to Appellants first, second, third and fourth arguments, *supra*. The Examiner has not identified subject matter within the cited references, and associated supporting argumentation, that demonstrates motivation to combine the references. Accordingly, Appellant contends that the Examiner's argument as to the motivation to combine the references is not persuasive.

Instead, the Examiner's Answer offers an alleged **new ground of rejection** that is improper because of the prohibition against entry of a **new ground of rejection** in the Examiner's Answer and because the teaching or suggestion to make the combination proper must not be found in Appellant's disclosure. See MPEP §1208.01 (stating "37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer.") See also MPEP §2143 (stating "the teaching or suggestion to make the combination proper must not be found in Appellant's disclosure.") The Examiner's Answer states:

"The examiner disagrees with the appellant's arguments because there is proper motivation to combine the references. US '070 is concerned with the same problem as in appellant's claims, repelling animals from plants." The Examiner's Answer, page 5, paragraph 11.

The Examiner's states the evidence that is the new ground of rejection, *infra*, i.e., that "**a person of ordinary skill in the art would reasonably expect that hot pepper extracts and onion extracts function equivalently in their ability to repel an animal from a substrate that needs to be protected from damage**" (emphasis added). The Examiner's Answer, page 5, paragraph 11. This is different than the original ground of rejection of Claims 1-4, and 6-12, that "a person of ordinary skill in the art would recognize that **the repellent composition taught**

by U.S. '973 could be used to repel animals from any surface that is known to be at risk for animal damage” (emphasis added). The Final Office Action, page 3, paragraph 7, and Paper 6, page 5, paragraph 9.

Regarding the characterization of a **new ground of rejection**, the MPEP states:

“There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, **and the evidence relied upon in support of the rejection remains the same**, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute **a new ground of rejection**. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute **a new ground of rejection**)” (emphasis added). MPEP §1208.01. Here, Appellant respectfully submits **the evidence relied upon in support of the new ground of rejection did not remain the same**, i.e., the Examiner’s Answer relies on **new evidence**, *infra*, arguing that

“US '070 is concerned with the same problem as in appellant's claims, repelling animals from plants. To achieve this purpose, US '070 applies a composition comprising eggs and hot pepper sauce to the plant. . . . US '973 also teaches using hot pepper extract to repel animals from substrates that are potentially damaged by animals. . . . The reference teaches that onion extracts can be used in place of the hot pepper extract (see column 3, lines 3-6). Thus, from the teaching of US '973, **a person of ordinary skill in the art would reasonably expect that hot pepper extracts and onion extracts function equivalently in their ability to repel an animal from a substrate that needs to be protected from damage**. Based on this reasonable expectation that onion extract will **function equivalently to the hot pepper extract in US '070**, a person of ordinary skill in the art would be motivated to substitute the hot pepper extract with an onion extract. Thus, this substitution would yield a method of repelling

animals from plants using a composition that comprises onion extract and egg” (emphasis added). The Examiner’s Answer, page 5, paragraph 11.

Appellant respectfully contends that MPEP §1208.01 prohibits entry of the new ground of rejection, i.e., that **“a person of ordinary skill in the art would reasonably expect that hot pepper extracts and onion extracts function equivalently in their ability to repel an animal from a substrate that needs to be protected from damage”** (emphasis added) in the Examiner’s Answer. Accordingly, Appellant contends that the rejection of Claims 1-4 and 6-12 as allegedly unpatentable under 35 U.S.C. 103(a) is improper and the Examiner should withdraw the rejection.

Appellant respectfully submits that the Examiner’s argument for motivation to combine U.S. ‘070 with U.S. ‘973 fails even if U.S. ‘070 is concerned with the same problem as in appellant's Claims, i.e. repelling animals from plants, because MPEP §2143 states the motivation to make the combination proper must not be found in Appellant’s disclosure. Here, the Examiner states there is proper motivation to combine the references because U.S. ‘070 is concerned with the same problem as in Appellant's Claims 1-4 and 6-12, i.e., repelling animals from plants. See the Examiner’s Answer, page 5, paragraph 11. Accordingly, Appellant contends that the rejection of Claims 1-4 and 6-12 as allegedly unpatentable under 35 U.S.C. 103(a) is improper and the Examiner should withdraw the rejection.

In light of the foregoing discussion, Appellants respectfully contend that Claims 1-4, and 6-12 are in condition for allowance under 35 U.S.C. 103(a) over U.S. ‘973 in view of U.S. ‘070.

Issue 2

Claims 1-3, 7, 11, and 12 Are Not Unpatentable Under 35 U.S.C. 103(a) Over Japanese Patent Application No. 1-139515 A ('515 A) in view of U.S. Patent No. 4,965,070 ('070).

Claims 1-3, 7, 11, and 12

As to whether there is no motivation to combine JP Pat. Application No. 1-139515 A ("JP '515") in view of U.S. Patent No. 4,965,070 ("U.S. '070"), the Examiner's Answer states:

"The appellant argues that there is no motivation to combine the two references because JP '515 is concerned with repelling animals from garbage while US '070 repels animals from plants. However, as is the case in the above rejections, both JP '515 and US '070 use substances that smell unpleasant to the pest to achieve repellency. As discussed above, US '070 is concerned with the same problem as in appellant's claims, repelling animals from plants." The Examiner's Answer, pages 6-7, paragraph 11.

Appellant respectfully submits that the preceding argument by the Examiner is vague and indefinite because the Examiner has not explained how the Examiner's statement, *supra*, supports the Examiner's rejection of Claims 1-3, 7, 11, and 12, as allegedly unpatentable under 35 U.S.C. 103(a) over JP '515 in view of U.S. '070. To establish a *prima facie* case of obviousness, three basic criteria must be met.

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP, §2143.

The Examiner states that Appellant argued in the Appeal Brief that there is no motivation to

combine the two references because JP `515 is concerned with repelling animals from garbage while US `070 repels animals from plants. Appellant submits that the Examiner has not articulated an argument or rationale that

“However, as is the case in the above rejections, both JP `515 and US `070 use substances that smell unpleasant to the pest to achieve repellency. As discussed above, US `070 is concerned with the same problem as in appellant's claims, repelling animals from plants” supports the Examiner’s rejection of Claims 1-3, 7, 11, and 12 as allegedly unpatentable under 35 U.S.C. 103(a) over JP `515 in view of U.S. `070. Id.

Appellant respectfully contends that the Examiner has not referenced any supporting passages or other evidence in the cited prior art to rebutt Appellant’s argument in the Appeal Brief that the Examiner’s use of U.S. `070 to modify JP `515 is an improper combination because the purpose of JP `515 is to prevent **garbage** from being rumaged or scratched by dogs, cats and birds and the purpose of U.S. `070 is to protect **plants**. Although the Examiner’s Answer, *supra*, argues that, both JP `515 and US `070 achieve repellency by using substances that smell unpleasant to the pest, and that US `070 is directed toward solving the same problem as in Appellant's Claims, i.e., repelling animals from plants, Appellant respectfully submits that the Examiner’s preceding argument, *supra*, is vague and indefinite because the Examiner’s Answer is silent with respect to Appellant’s arguments in the Appeal Brief. The Examiner has not identified subject matter within the cited references, and associated supporting argumentation, that demonstrates motivation to combine the references. Accordingly, Appellant contends that the Examiner’s argument as to the motivation to combine the references is not persuasive.

Instead, the Examiner’s Answer offers an alleged **new ground of rejection** that is

improper because of the prohibition against entry of a **new ground of rejection** in the Examiner's Answer and because the teaching or suggestion to make the combination proper must not be found in Appellant's disclosure. See MPEP §1208.01 (stating "37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer.") See also MPEP §2143 (stating "the teaching or suggestion to make the combination proper must not be found in Appellant's disclosure.") The Examiner's alleged **new ground of rejection** improperly rejects Claims 1-3, 7, 11, and 12 under 35 U.S.C. 103(a) for the first time in the Examiner's Answer, as apparently unpatentable over U.S. '070 in view of JP '515. In addition to the fact that the Examiner rejected Claims 1-3, 7, 11, and 12 as allegedly unpatentable under 35 U.S.C. 103(a), using JP '515 as the primary reference in the Final Office Action, instead of U.S. '070 as in the alleged **new ground of rejection**, Appellant's contention that the Examiner relies on an alleged **new ground of rejection** is based on the following:

"Based on this reasonable expectation that onion will function equivalently to the pepper in US '070, a person of ordinary skill in the art would be motivated to substitute the hot pepper extract with onion. Thus, this substitution would yield a method of repelling animals from plants using a composition that comprises onion and egg" (emphasis added). The Examiner's Answer, page 7, paragraph 11.

The Examiner states the new evidence that arises to the prohibited new ground of rejection in the Examiner's Answer, *supra*, i.e., **"Based on this reasonable expectation that onion will function equivalently to the pepper in US '070, a person of ordinary skill in the art would be motivated to substitute the hot pepper extract with onion"** (emphasis added). The Examiner's Answer, page 7, paragraph 11. This is different than the original ground of

rejection of Claims 1-4, and 6-12, in the Final Office Action, that “a person of ordinary skill in the art would recognize that **both references are concerned with the same problem, repelling animals from food sources.**” (emphasis added). The Final Office Action, page 3, paragraph 7, and Paper 6, page 5, paragraph 9.

Regarding the characterization of a **new ground of rejection**, the MPEP states:

“There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, **and the evidence relied upon in support of the rejection remains the same**, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a **new ground of rejection**. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a **new ground of rejection**)” (emphasis added). MPEP §1208.01. Here, Appellant respectfully submits **the evidence relied upon in support of the new ground of rejection did not remain the same**, i.e., the Examiner’s Answer relies on **new evidence**, *supra*, i.e., “Based on this **reasonable expectation that onion will function equivalently to the pepper in US ’070, a person of ordinary skill in the art would be motivated to substitute the hot pepper extract with onion**” (emphasis added). The Examiner’s Answer, page 7, paragraph 11. This **evidence** is prohibited in the Examiner’s Answer under MPEP §1208.01 because it is **new** compared to the original evidence cited in the Final Office Action that was referenced to support the status of Claims 1-3, 7, 11, and 12 under Appeal as rejected allegedly because Claims 1-3, 7, 11, and 12 are unpatentable under 35 U.S. 103(a) over JP ’515 in view of U.S. ’070. Accordingly,

Appellant contends that the rejection of Claims 1-3, 7, 11, and 12 as allegedly unpatentable under 35 U.S.C. 103(a) is improper and the Examiner should withdraw the rejection. Appellant respectfully contends the Examiner's alleged **new ground of rejection** is improper when Appellant has not had an opportunity to respond to the Examiner's **newly made alleged ground of rejection**. See MPEP §1208.01 (stating "37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer.")

Appellant respectfully submits that the Examiner's argument for motivation to combine U.S. '070 with JP '515 fails even if U.S. '070 is concerned with the same problem as in Appellant's Claims, i.e. repelling animals from plants, because MPEP §2143 states the motivation to make the combination proper must not be found in Appellant's disclosure. Here, the Examiner states there is proper motivation to combine the references because U.S. '070 is concerned with the same problem as in Appellant's Claims 1-3, 7, 11, and 12, i.e., repelling animals from plants. See the Examiner's Answer, page 7, paragraph 11. Accordingly, Appellant contends that the rejection of Claims 1-3, 7, 11, and 12 as allegedly unpatentable under 35 U.S.C. 103(a) is improper and the Examiner should withdraw the rejection.

Even if the Examiners **new ground of rejection** were not prohibited in the Examiner's Answer under MPEP §1208.01, Appellant respectfully submits that the Examiner's argument that the references teach **the functional equivalence of pepper and onion extracts for repelling animals from a plant** fails because there is no motivation for an artisan skilled in the art to combine the references cited by the Examiner. The Examiner acknowledges that U.S. '070 discloses a **deer** repellant composition made from hot pepper sauce and egg. JP '515 and U.S. '973 are directed to **onion** containing compositions for repelling **dogs** and **cats** from garbage or

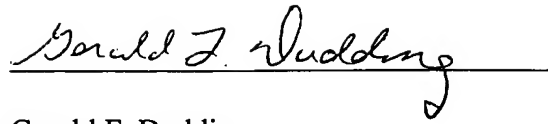
pests from animal carcass substrates. The Examiner has not presented any evidence showing that **deer** are repelled by **onion** on any substrate. Therefore Appellant contends that absent supportive subject matter that the Examiner has not cited, there is no motivation to modify U.S. '070 by the disclosures of JP '515 or U.S. '973, because one skilled in the art would not be motivated to modify U.S. '070, directed to repelling deer from plants with the disclosures of JP '515 or U.S. '973, directed to repelling animals that are not deer from either garbage or dead carcasses. See U.S. '070, JP '515 and U.S. 973 generally. Appellant respectfully submits that even if the Examiner's **new ground of rejection** were not prohibited in the Examiner's Answer under MPEP §1208.01, the Examiner's argument that the references teach the "**reasonable expectation that onion will function equivalently to the pepper in US '070, a person of ordinary skill in the art would be motivated to substitute the hot pepper extract with onion**" fails, because there is no motivation for an artisan skilled in the art to combine the references cited by the Examiner (emphasis added). The Examiner's Answer, page 7, paragraph 11.

In light of the foregoing discussion, Appellants respectfully contend that Claims 1-3, 7, 11, and 12 are in condition for allowance under 35 U.S.C. 103(a) over JP '515 in view of U.S. '070.

Respectfully Submitted,

Date: May 17, 2004

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A handwritten signature in cursive script, reading "Gerald F. Dudding", is written over a horizontal line.

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